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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,070	03/16/2001	Hiroshi Itani	914-125	5553
23117	7590	02/24/2005	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			YUAN, ALMARI ROMERO	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/809,070	ITANI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Almari Yuan	2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2176

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed on 10/01/04.
2. The rejection of claims 1-9 under 35 U.S.C. 103(a) as being unpatentable over Hill and Birrell has been withdrawn in light of newly found art.
3. Claims 10-13 are newly added. Claims 1-13 are pending in the case. Claims 1, 4, 7, 10, 11, 12, and 13 are independent claims.

### ***Drawings***

4. The drawings were received on 10/01/04. These drawings are acceptable by the Examiner.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thro et al. (USPN 6,147,977 – filed 12/1997) and Huna (USPN 6,438,217 B1 – filed 03/1999).**

**Regarding independent claims 1, 4, 7, and 10-13, Thro discloses:**

An electric mail sending apparatus, comprising:

an attribute table storing a display form defined based on a terminal model name (Thro on col. 4, lines 65-66, see Figure 2, item 74: teaches display preference table);

an accepting device for accepting a receiver's terminal model name that is input by a user (Thro on col. 5, lines 2-11 teaches user selects type of display format the incoming messages should be displayed);

a reader connected to the attribute table and the accepting means for reading the display form defined based on the receiver's terminal model name from the attribute table (Thro on col. 5, lines 3-25 teaches the user's cellular telephone can display the message as a page or voice from reading user's selected preferences);

a display connected to the editing device and the reader for displaying the electric mail text based on the display form read from the attribute table (Thro on col. 4, line 65- col. 5, line 25: teaches user selects type of display format indicated in the display preference table);

a sending device connected to the editing device for sending the electric mail (Thro on col. 5, lines 22-25 teaches sending messages to the user's cellular telephone).

However, Thro does not explicitly disclose "an editing device for composing and editing a text of an electric mail" and "wherein the electric mail text based on the display form is displayed on the display of the electric mail sending apparatus before the electric mail is sent by the sending device to the receiver's terminal".

Huna discloses creating and composing a message on a data entry web page; wherein the message text on the data entry area can be previewed as plain text or html before sending the message to the recipient; when the message is sent to the recipient device the message is

Art Unit: 2176

translated to the format compatible with receive device (see Figures 6-7 and Figure 8, items 810, 816, and 822, and col. 16, lines 24-29).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Huna into Thro to provide a data entry area to compose a message and preview the message before sending it to the recipient's device, as taught by Huna, incorporated into the messaging system of Thro, in order to provide the capability of composing future messages in a type of format compatible to the receiving device.

**Regarding dependent claims 2, 5, and 8, Thro discloses:**

wherein the attribute table stores a number of lines that is displayable on a display screen of a receiver's terminal and a number of characters per line, the reading means includes number-of-character reading means for reading the number of lines that is displayable on the display screen of the receiver's terminal and the number of characters per line, and the display means includes means connected to the editing means and the number-of-character reading means for displaying the electric text based on the displayable number of lines and the number of characters per line that are read from the attribute table (Thro on col. 4, lines 65-66 teaches display preference table 71 includes a field for devices and a field for display format and on col. 5, lines 11-25 teaches if the user selected that the messages, sent to the facsimile machine, are to be displayed in a standard facsimile format).

**Regarding dependent claims 3, 6, and 9, Thro discloses:**

wherein the display means displays copy data of the electric text based on the display form read from the attribute table (Thro on col. 5, lines 2-11 teaches the message content should only be displayed in text format).

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is 571-272-4104. The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AY  
February 21, 2005

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER